

REMARKS

Claims 15 to 23 are added, and therefore claims 8 to 23 are pending.

Reconsideration is respectfully requested based on the following.

It is noted that essentially corresponding claims (as previously presented) have been allowed in the corresponding European application.

Also, the present rejections are not understood since Examiner Blair spoke with Aaron C. Deditch (Reg. No. 33,865) on December 9, 2009, and advised that claims 20 to 23 (and any appropriate dependent claims) contained allowable subject matter.

Claims 8 to 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,152,094 (the “Jannu” reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 8, as presented, is to a device for connecting subnets in a vehicle, including “a gateway unit configured to connect at least two subsystems”, in which the “gateway unit is

made of at least one modular software gateway, which routes messages between only two subnets in a vehicle.”

The Office Action cites Figure 1 and column 1, lines 38 to 58, of the Jannu reference as to claim 8. In particular, it is conclusorily asserted that “connection 101-115 is considered a modular software gateway.” It is respectfully submitted that nothing in Jannu identically discloses (or even suggests) a modular software gateway, as provided for in the context of the presently claimed subject matter. The specification of the present application specifically states that a modular software gateway provides for “expand[ing] gateways *without need for changing the existing gateway software and/or the existing configuration tables.*” The present application further discloses that “[a]dding or omitting such a modular gateway when changing the network topology avoids such changes.” (Specification, page 1, lines 29, (emphasis added)).

In stark contrast, the Jannu reference states the following:

[I]f each type of technology uses its own data format, a *specifically designed adapter* is needed between each pair to allow communication between the two.... [T]he point-to-point approach creates vendor dependency. The adapters between platforms must meet the requirements of the manufacturers of each system. ***If a piece of equipment is replaced, the adapters between the new equipment and all other systems must be redesigned.***

(Jannu, col. 1, lines 51 to 58 (emphasis added)). Thus, even if it is assumed (for this response) that elements 101 to 115 of the Jannu reference are gateways, as conclusorily asserted by the Office Action, the Jannu reference makes plain that it is not a “modular software gateway”, let alone one that is “connecting subnets in a vehicle”, as provided for in the context of the claimed subject matter. In Jannu, the “adapters between the new equipment” are not modular but “must be redesigned.” Thus, there is no reasonable interpretation that supports the assertion that the cited section of Jannu discloses a “modular software gateway” as in claim 8. This is because Jannu specifically teaches that its system is not modular.

Accordingly, claim 8, as presented, is allowable, as are its dependent claims 9 to 13, 22, and 23.

Claim 14, as presented, includes features like those of claim 8, including the feature of a “gateway unit configured to connect at least two subsystems, the gateway unit being

integrated in a control unit having an application system and being provided in one layer of a communication system of the vehicle, the gateway unit including at least one modular logical gateway, the logical gateway connecting only the at least two subsystems in the vehicle, the subsystems being subnets."

Claim 14, as presented, is therefore allowable for essentially the same reasons as claim 8, as presented, as are its dependent claims 15 to 21.

Also, the present rejections are not understood since Examiner Blair spoke with Aaron C. Deditch (Reg. No. 33,865) on December 9, 2009, and advised that claims 20 to 23 (and any appropriate dependent claims) contained allowable subject matter.

Accordingly, claims 8 to 23 are allowable.

CONCLUSION

In view of the foregoing, all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

KENYON & KENYON LLP

Dated: 3/16/2009

By: 

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646

33,865

Aaron C
DEDITCH